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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,399

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Soner Yamen

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ERICSSON INC.  
6300 LEGACY DRIVE  
M/S EVR 1-C-11  
PLANO, TX 75024

EXAMINER

GEORGEWILL, OPIRIBO

ART UNIT

PAPER NUMBER

2617

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,399	<b>Applicant(s)</b> YAMEN, SONER	
	<b>Examiner</b> OPIRIBO GEORGEWILL	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/12/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim **9**, the claim recites a database for storing subscriber related data containing, and further recite a processing unit for controlling the database. The recitation leaves doubt to the metes and bounds of the claim. It is not clear to a person having ordinary skills in the art if the processing unit inside the database is to controls the database of which it is inside and a part of.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.

**4. Claims 1, 2, 3, 4, 7, 8, 9, 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Einola et al., US Pat No. 6771964 B1.**

Re claim 1, Einola discloses a method for handling user equipment in a communications network comprising at least a first access network and a second access network for enabling a user equipment to access said communications network , wherein the access networks have at least a partially overlapping service area, and wherein the user equipment located in a partially overlapping service area can be transferred from the first to the second access network(col 2, lines 55 – 64, where Einola discloses a handover (transfer of service) from an overlapping serving and neighborhood network (first and second access network); col 3, lines 13 – 15, a multi mode mobile station capable of communicating with different wireless networks), said method comprising the following steps:

receiving an indication of a request for transferring at least one user equipment from said first access network to said second access network (col 2, line 65 – col 3, line 12, provided with information (indication of a request to transfer at least one user equipment) ... may be handed over to another network; also see col 3, lines 38 – 65, message (indication) is sent to the serving wireless network (first access network);,

checking a transfer permission parameter value associated to a user equipment, determining that the transfer permission parameter value indicates that a transfer

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of the associated user equipment is permitted (col 3, line 66 – col 4, line 2, permission for the user to utilize the neighboring wireless network), determining that the transfer permission parameter value indicates that the user equipment belongs to a group of user equipment, for which a preferred access network has been defined (col 3, line 66 – col 4, line 2; col 6, lines 24 – 35 Einola discloses that preference parameter include GSM preferred, implies that user equipment belongs to a GSM group of equipment that GSM preferred access networks is defined), and initiating, based on the determination, the transfer of the user equipment from the first to the second access network (col 3, line 31 – 34).

The rejection of claim 1 is incorporated herein. Claims 2, 3, 4 depend on claim 1 and only further limitations will be addressed below.

Re claim **2**, Einola discloses that the access network operates according to the standards defined for Global System for Mobile Communication, Wide-band Code Division Multiple Access (fig 1, ref 12, 28, Einola disclose a GSM and UMTS network)

Re claim **3**, Einola discloses that the group of user equipment for which a preferred access network has been defined comprises user equipment with service capability limited to services with correspond to services supported on the second network (col 6, lines 24 – 38, from the disclosure of Einola, when the serving network (first access network) is a GSM network, and the preference parameter of UMTS preferred)

Re claim **4**, Einola discloses that the group of user equipment for which a preferred access network has been defined comprises user equipment associated with service capabilities limited to services which correspond to services supported by the second network (col 3, line 66 – col 4, line 2, permission of the user; col 6, lines 24 – 41, subscriber's preferred connection properties and other subscription data)

Re claim **7**, it is drawn to the apparatus by the corresponding method claim 1 and is rejected for the same reasons as above.

The rejection of claim 7 is incorporated herein. Claim 8 depends on claim 7 and only further limitations will be addressed below.

Re claim **8**, it is drawn to the apparatus by the corresponding method claim 1 and is rejected for the same reasons as above.

Re claim **9**, Einola discloses a database for storing subscriber related data (col 4, line 55 – 57). It is furthermore drawn to the apparatus by the corresponding method claim 1, and is rejected for the same reasons as above. It is also noted that the recitation of “storage” is not defined in the specification of the disclosure. However, for compact prosecution reasons, it will be construed by the examiner to be a statutory product.

Re claim **10**, it is drawn to the apparatus by the corresponding method claim 1 and is rejected for the same reasons as above

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: **(See MPEP Ch. 2141)**

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

6. **Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Einola et al., US Pat No. 6771964 B1 in view of Lescuyer, Pierre., European Pub No. 1257141 A1.**

The rejection of claim 1 is incorporated herein. Claims 5 and 6 depend on claim 1 and only further limitations will be addressed below.

Re claim 5, Einola discloses wherein the group user equipment for which a preferred access network has been defined comprises user equipment associated with a subscription for which services are permitted (col 3, line 66 – col 4, line 2; col 6, lines 24 – 41). Einola is silent on the services not supported by the first network. Lescuyer in analogous art discloses a method of operating at least a first and second access networks where the mobile phone sends a

indication of a request for transfer of at least one user equipment to the first access network and the first network decides and initiate transfer based on the request (see abstract) so as to allow change of RAT even between uncoordinated radio access networks (paragraph [11]). Lescuyer further discloses that a mobile may be able to detect the pilot or beacon or the presence of a HIPERLAN local area network and the user decides to switch to this network if the current download rate is too slow on the current system or the file is too big and the HIPERLAN alternative (service that is not supported by the first network) is likely to provide a faster solution (paragraph [13]). It would have been obvious to a person having ordinary skills in the art, at the time of the invention, to incorporate the teaching of Lescuyer into the disclosure of Einola, to have services not supported by the first network so as to allow change of RAT even between uncoordinated radio access networks.

Re claim **6**, the combined teaching of Einola in view of Lescuyer, as a whole, discloses that the group of user equipment for which a preferred access network has been defined comprises user equipment with service capacities corresponding to services (Einola: col 6, lines 24 – 41) that are not supported by the first network (paragraph [13], the file is too big and the HIPERLAN alternative is likely to provide a quicker solution).



***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OPIRIBO GEORGEWILL whose telephone number is (571)270-7926. The examiner can normally be reached on Monday through Thursday, 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OPIRIBO GEORGEWILL/  
Examiner, Art Unit 2617

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617

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